

## **DETAILED ACTION**

### ***Election/Restrictions***

1. The reply filed on 7-07-08 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): In the reply filed 7-07-2008 Applicants elected invention Group I, claims 1-2 and 4-5, drawn to DNA encoding a protein having 16-position hydroxylating enzymatic activity, partly or entirely or its variant. However, there was no further election from Group I, specifically from the following groups wherein said variant is selected from the following:

A. The 16-position hydroxylating enzymatic activity is for macrolide compound 11107B, and is selected from the group consisting of:

1. A continuous nucleotide sequence from base 1322 to base 2548 of SEQ ID NO: 1;
2. A continuous nucleotide sequence from the base 420 to 1604 of SEQ ID NO: 2;
3. A continuous nucleotide sequence from the base 172 to base 1383 of SEQ ID NO: 3;
4. A variant of the sequences in 1-3 above, that hybridizes to the above sequences under stringent conditions, and encodes a protein having hydroxylating enzymatic activity for macrolide compound 11107B.
5. A degenerate variant of one of the sequences in 1-3 above.

B. The 16-position hydroxylating enzymatic activity is for macrolide compound 11107D.

2. Applicants were required to elect from one of the sequences set forth in part A.1, A.2, A.3, (upon further consideration, an election from A.1-A.3 would also include the corresponding variant set forth in parts A.4 and A.5), and B.

3. As stated in the prior Election/Restriction requirement, the inventions listed as Group I do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical

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features for the following reasons: The DNA sequences set forth in Group I, do not share a special technical feature since the shared relationship between these sequences does not make a contribution over the prior art. Document WO2003-040370 A1 describes a protein having the capability of metabolizing a weed control active compound. This protein is a ferredoxin and has homology of about 80-90% with the base sequences of sequence 1-3 of the present application. Therefore, the DNA that encodes, in part or as a whole, a protein having 16-hydroxylase activity or a ferredoxin used in a production wherein a specific macrolide derivative is converted into a 16-hydroxylated macrolide compound could be easily be conceived of by an expert of skill in the art by following the teachings of the cited document.

4. Moreover, see 37 CFR 1.475(c), which states:

"If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present."

37 CFR 1.47(d) also states:

"If multiple products, processes of manufacture, or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT article 17(3)(a) and 1.476(c)."

Instant Groups I-IX are drawn to multiple distinct products and methods, the instant claims read on multiple categories of invention, therefore the instant groups which set forth the various products and groups recited in the claims are determined to lack unity of invention.

5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

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6. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Ford whose telephone number is 571-272-0757. The examiner can normally be reached on M-F, 10:00 AM through 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Janet L. Epps-Ford/  
Primary Examiner, Art Unit 1633

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